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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,474	10/20/2003	Bruce P. Konen	1110-0462	7873

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EXAMINER

FLORES SANCHEZ, OMAR

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/689,474

Applicant(s)

KONEN, BRUCE P.

Examiner

Omar Flores-Sánchez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7,9-12 and 14-21 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 8 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 03/17/05.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Yo (5067240).

You discloses (Fig. 1-6) the invention including housing 10, first and second cutting blades (20 and 30) and a drive assembly including a drive shaft 42. Yo is capable of being use with a power drill by connecting the driving end 43 to the chuck.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3, 4, 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace (4317282) in view of You (5067240).

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Pace discloses the invention substantially as claimed including a power drill (see Fig. 1), a chunk 20, a handle (see Fig. 1), a drive assembly including a drive shaft 19, a torque arm 10, a torque arm clamp 17 and an attachment element comprises a hook (see Fig. 1-2, the part that connect with the handle) and the torque arm attached to the grip portion of the handle. Pace does not show first and second cutting blades. However, You teaches the use of first and second cutting blades (20 and 30) for the purpose of cutting cable or plastic pipe. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Pace's cutter by providing the first and second cutting blades as taught by You in order to obtain a device to cuts cable or plastic pipe.

6. Claims 1, 3, 4, 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Pace (4317282).

You discloses the invention substantially as claimed including housing 10, first and second cutting blades (20 and 30) and a drive assembly including a drive shaft 42. You does not show a torque arm, a torque arm clamp and an attachment element comprises a hook. However, Pace teaches the use of a torque arm 10, a torque arm clamp 17 and an attachment element comprises a hook (see Fig. 1-2, the part that connect with the handle) for the purpose of better supporting the cutter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the torque arm, the torque arm clamp and the hook as taught by Pace in order to obtain a better support.

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7. Claims 2 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Pace (4317282) as applied to claims 1 and 20 above, and further in view of Lazarevic (6065212).

The modified device of You discloses the invention substantially as claimed including a worm 41. You does not show a worm gear, a drive gear and a main shaft. However, Lazarevic teaches the use of a worm gear 28, a drive gear 64 and a main shaft (See Fig. 10) for the purpose of obtaining a large torque, which increase the cutting force. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the worm gear, the drive gear and the main shaft as taught by Lazarevic in order to obtain a large torque which increases the cutting force.

8. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Pace (4317282) as applied to claim 1 above, and further in view of Rudolf et al. (6155916).

The modified device of You discloses the invention substantially as claimed except for a stabilizing handle that can be attached to left and right sides. However, Rudolf et al. teach the use of a stabilizing handle 30 that can be attached to left and right sides (see Fig. 1) for the purpose of allowing right and left hand operators use the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's device by providing the stabilizing handle as taught by Rudolf et al. in order to obtain a device that can be use by right and left hand operators.

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9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace (4317282) in view of You (5067240) as applied to claim 1 above, and further in view of Rudolf et al. (6155916).

The modified device of Pace discloses the invention substantially as claimed except for a stabilizing handle that can be attached to left and right sides. However, Rudolf et al. teach the use of a stabilizing handle 30 that can be attached to left and right sides (see Fig. 1) for the purpose of allowing right and left hand operators use the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Pace's device by providing the stabilizing handle as taught by Rudolf et al. in order to obtain a device that can be use by right and left hand operators.

10. Claims 9, 15-16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Lazarevic (6065212).

You discloses the invention substantially as claimed including a worm 41, housing 10, first and second cutting blades (20 and 30), a drive assembly including a drive shaft 42, a cut away portion 12 and a segment gear 35. You does not show a worm gear, a drive gear and a main shaft. However, Lazarevic teaches the use of a worm gear 28, a drive gear 64 and a main shaft (See Fig. 10) for the purpose of obtaining a large torque, which increase the cutting force. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the worm gear, the drive gear and the main shaft as taught by Lazarevic in order to obtain a large torque which increase the cutting force.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Lazarevic (6065212) as applied to claim 9 above, and further in view of Pace (4317282).

The modified device of You discloses the invention substantially as claimed except for a torque arm. However, Pace teaches the use of a torque arm 10 for the purpose of better supporting the cutter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the torque arm as taught by Pace in order to obtain a better support.

12. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Lazarevic (6065212) as applied to claim 9 above, and further in view of Rudolf et al. (6155916) and Pace (4317282).

The modified device of You discloses the invention substantially as claimed except for a stabilizing handle that can be attached to left and right sides and a torque arm. However, Rudolf et al. teach the use of a stabilizing handle 30 that can be attached to left and right sides (see Fig. 1) for the purpose of allowing right and left hand operators use the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's device by providing the stabilizing handle as taught by Rudolf et al. in order to obtain a device that can be use by right and left hand operators.

Regarding to the torque arm, Pace teaches the use of a torque arm 10 for the purpose of better supporting the cutter. It would have been obvious to one having ordinary skill in the art at

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the time the invention was made to have modified You's cutter by providing the torque arm as taught by Pace in order to obtain a better support.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Lazarevic (6065212) as applied to claim 9 above, and further in view of Hirabayashi (5642566).

The modified device of You discloses the invention substantially as claimed except for a brush. However, Hirabayashi teaches the use of a brush 8 for the purpose of maintaining the dust away of the gears. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the brush as taught by Hirabayashi in order to maintain the dust away the gears.

14. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirabayashi (5642566).

Hirabayashi discloses (fig. 1-25) the invention substantially as claimed including a housing 3, first and second cutting blades (1 and 2), a drive assembly having a main shaft (29 and 34)(see col. 5, lines 26-27) and two bearings (see Fig. 6). Hirabayashi doesn't show a third bearing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Hirabayashi's device by providing a third bearing, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

15. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) as applied to claim 20 above, and further in view of Lazarevic (6065212).

You discloses the invention substantially as claimed including a worm 41. You does not show a worm gear, a drive gear and a main shaft. However, Lazarevic teaches the use of a worm gear 28, a drive gear 64 and a main shaft (See Fig. 10) for the purpose of obtaining a large torque, which increase the cutting force. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the worm gear, the drive gear and the main shaft as taught by Lazarevic in order to obtain a large torque which increases the cutting force.

#### ***Allowable Subject Matter***

16. Claims 8 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

17. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Applicant argues Yo does not suggest using his device with a power drill. However, Yo is capable of being use with a power drill by connecting the driving end 43 to the chuck. Also, there is evidence that Yo's device is not capable of being use with a power drill. In response to applicant's argument that the combination of Yo and Lazarevic is

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nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both are in the same field of cutting tube or pipe (see Background of the Invention of Yo's reference).

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hutchins and Dickey et al. are cited to show related device.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Flores-Sánchez whose telephone number is 571-272-4507. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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6/13/05



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